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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/661,228 | 09/12/2003 | Paul Spaeth | 16222U-012510US | 6840 |
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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

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| EXAMINER |
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LABAZE, EDWYN

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| ART UNIT | PAPER NUMBER |
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2876

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|-------------------------------|---|
| Office Action Summary | Application No. 10/661,228 | Applicant(s) SPAETH ET AL. | |
| | Examiner EDWYN LABAZE | Art Unit 2876 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-15,17-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-15,17-22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 9/2/2005.
2. Claims 1-2, 4-8, 10-15, 17-22, and 24-27 (including new claims 25-27) are presented for examination.
3. This application claims the benefits of 60/410,555 filed on 09/13/2002.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-2, 4-8, 10-15, 17-22, and 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al. (U.S. 6,427,140).

Re claims 1, 5, 7, 13, 18, 20, and 25: Ginter et al. {hereinafter referred as "Ginter"} discloses systems and methods for secure transactions management and electronic rights

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protection, which includes a token acceptance device configured to receive the portable token, the portable token having a current token image {such as fingerprint information, identification information and the like; cols. 33-42}; wherein the portable token {herein a smartcard 600/2600; col.231, lines 50+} is configured to be used in financial transactions (col.232, lines 23+); and a server configured to communicate with the portable token via the token acceptance device (col.225, lines 40+); wherein upon receiving an indication that the token image on the portable token is to be updated, the server retrieves a backup token image for the portable token and uploads the backup token image to the portable token via the token acceptance device to replace the current token image on the portable token, the backup token image comprising updated financial or loyalty transaction information for the portable token (see col.143, lines 10+; cols.165-169, lines1-67). Ginter further a processing server configured to communicate with the portable token via the token acceptance device (col.225, lines 40-67), means of uploading the backup token image to the portable token, maintaining one or more backup token images at a token image server (cols.163-167, lines 1-67).

Re claim 2: Ginter teaches system and methods, further comprising a token image server {herein Ginter teaches a VDE server having one or more protected processing environments 650 could communicate over a network with workstations that do not have a protected processing environment, and could perform all secure VDE processing; col.225, lines 40-67} configured to store a plurality of backup token images {through a secure backup database 610 (col.216, lines 23+); wherein the retrieved backup token image is selected from the plurality of backup token images based on one or more predetermined criteria (cols.211-212, lines 10+).

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Re claims 4, 10, 15, and 22: Ginter discloses system and method, wherein upon replacing the current token image with the backup token image on the token, an indicator in the portable token is set to ensure that no further update {herein Ginter teaches means of permitting the user access to certain information content; see col.182, lines 5-15} is to be performed (cols.179-182, lines 1-67).

Re claims 6, 12, and 19: Ginter teaches system and method, wherein the token acceptance device 600 is one of a point-of-sale device, a cellular phone, a personal digital assistant, a personal computer (PC), a tablet PC, a handheld specialized reader, a set-top box, an electronic cash register, a virtual cash register, a kiosk, a security system, and an access system (col.60, lines 12-56).

Re claims 8, 14, and 21: Ginter discloses system and method, wherein the retrieved backup token image is selected from the plurality of backup token images based on one or more predetermined criteria (cols.164-166, lines 1-67).

Re claims 11, 17, and 24: Ginter teaches system and method, wherein the portable token {herein an electronic currency or credit} is one of a smartcard, a cellular phone, a personal digital assistant, a pager, a payment card, a security card, an access card, smart media and a transponder (herein a smartcard 600/2600; col.231, lines 50+; also see cols.232, 235, 237; lines 22+, 5+, 15+ respectively).

Re claim 26: Ginter discloses system and method, wherein the first portable device and the second portable device comprise a smart card (col.237, lines 18+).

Re claim 27: Ginter teaches system and method, wherein the backup token image comprises transaction information for a financial account (col.232, lines 22+).

Response to Arguments

6. Applicant's arguments with respect to claims 1-2, 4-8, 10-15, 17-22, and 24-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Friedes et al (U.S. 5,521,966) teaches method and system for mediating transactions that use portable smart cards.

Mikurak (U.S. 6,606,744) discloses providing collaborative installation management in a network-based supply chain environment.

Tan et al. (US 2001/0045451) teaches method and system for token-based authentication.

DiRaimondo et al. (US 2004/0225776) discloses method of regulating usage and/or concession eligibility via distributed list management in a smart card system.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
November 7, 2005



THIEN M. LE
PRIMARY EXAMINER